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SUPREME COURT U.S.

No. 07-150

IN THE

Supreme Court of the United States

NOURI E. HAKIM,

Petitioner,

v.

CANNON AVENT GROUP, PLC, *et al.*,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. Whether Petitioner has presented compelling reasons to grant the Petition where the Federal Circuit affirmed the district court's application of the doctrine of prosecution disclaimer so as to limit the scope of the patentee's invention consistent with his clear, unmistakable and unretracted statements to the Patent Office?

2. Whether Petitioner has presented compelling reasons to grant the Petition where the Federal Circuit affirmed the district court's claim construction based upon the intrinsic evidence?

PARTIES TO THE PROCEEDING

The full name of every party represented by us is: Avent Group Limited (f/k/a Cannon Avent Group PLC) Avent Limited (f/k/a Cannon Rubber Limited) Avent America, Inc.

CORPORATE DISCLOSURE STATEMENT

The respondents are Avent Group Limited (f/k/a Cannon Avent Group PLC), Avent Limited (f/k/a Cannon Rubber Limited) and Avent America, Inc.

All parent corporations and any publicly held companies that own 10 percent or more of the stock of any reaspondent are:

Avent Group Limited (f/k/a Cannon Avent Group PLC) is the parent company of Avent Limited (f/k/a Cannon Rubber Limited) and Avent America, Inc.

Avent Finance Limited is the parent company of Avent Group Limited (f/k/a Cannon Avent Group PLC).

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INTRODUCTION

Petitioner has presented *no* "compelling reasons" that warrant the grant of his Petition for a Writ of Certiorari. *See* Sup. Ct. R. 10.

Contrary to Petitioner's assertions, the Federal Circuit did *not* proclaim a "new rule of prosecution disclaimer." Nor did it issue any holding contrary to this Court's precedent. Indeed, the very premises of the Petition, as set forth in Petitioner's Questions Presented, are based on misstatements of fact and law.

First, the Federal Circuit most certainly did *not* read a limitation back into an issued patent claim after removal of that limitation during prosecution. The fact is that the limitation in question was *never* removed.

As the Federal Circuit explicitly noted, the patentee unequivocally represented to the United States Patent and Trademark Office ("PTO") that his claimed invention was patentable over the prior art because his invention provides two separate sealing mechanisms to close off the passage of fluid — a flexible valve member with a slit that opens or closes depending on whether suction is applied or not, and a blocking element on which the slit sits to further block liquid flow. *See* Appendix A[1] at 3a-4a. Significantly, at the time these distinguishing arguments were made, thirteen of the nineteen pending claims recited "opening"; only six of the pending claims recited "slit."

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[1] Citations to Appendix A refer to the appendix provided in Petitioner's brief.

Thus, as the Federal Circuit recognized, the limitation in question applied to claims that recited "opening" as well as those that recited "slit":

> . . . during prosecution the presence of the slit in the flexible valve material was emphasized as distinguishing *all* of the claims from the cited references.

See Appendix A at 4a (emphasis added).

The patentee's later amendment to change some of the allowed claims to recite "opening" instead of "slit," did not broaden or change the meaning of "opening" because the patentee's previous disclaimer applied to claims that recited "opening." Thus, the patentee did *not* remove from the claims the limitation the patentee had argued for patentability, namely, that the claimed "opening" operates as a slit to provide the required two separate sealing mechanisms.

Moreover, in amending some claims to substitute the term "opening" for "slit," the patentee did *not* disavow his previous disclaiming arguments. Instead, he expressly adopted and relied upon his earlier prosecution arguments to obtain allowance of the amended claims.

In affirming the district court's holding that prosecution disclaimer limited the scope of the patentee's claims the Federal Circuit did not proclaim any new law, but explicitly followed the well established precedent of this Court. *See* Appendix A at 8a.

Petitioner's second premise for its Petition, namely that the Federal Circuit supposedly held that claim construction

and patent validity rulings can be entered without reliance on the evidentiary underpinnings required by this Court's precedent, also has no basis in law or fact.

Contrary to Petitioner's assertions, the Federal Circuit did *not* hold that claim construction regarding *disputed* terms may "not be necessary." *See* Petition at 3. Rather, the Federal Circuit explained that claims need only be construed to the extent required to resolve the parties' dispute. Specifically, the Federal Circuit held that:

> Claim construction is directed to claims or claim terms whose meaning is disputed as applied to the patentee's invention in the context of the accused device. *When there is no dispute as to the meaning of a term that could affect the disputed issues of the litigation, "construction" may not be necessary.*

See Appendix A at 11a (emphasis added).

And as to the disputed claim terms, the Federal Circuit went on to reject Petitioner's construction of "closed position" as well as Petitioner's argument that the district court had failed to address the claim terms "begins to invert." *See* Appendix A at 12a-14a. Indeed, the Federal Circuit actually quoted from the district court's analysis of that claim term. *See* Appendix A at 14a. Petitioner's "evidence" for a contrary meaning of "invert" was expressly excluded by the district court because the "evidence" comprised merely conclusory statements contained in Petitioner's own "expert" declaration submitted late, after the close of expert discovery. The Federal Circuit held that the district court properly excluded Petitioner's declaration. *See* Appendix A at 14a.

The bottom line is that the Federal Circuit and district court fully considered and correctly decided each of the issues Petitioner raises. And in doing so, the courts below followed well-established precedent of this Court. There is simply no basis for the grant of certiorari here.[2]

STATEMENT OF THE CASE

In this case, the Petitioner alleged infringement of two patents — U.S. Patent No. 6,321,931 (the "'931 patent") and U.S. Patent No. 6,357,620 (the "'620 patent"). Both patents are entitled: "No-Spill Drinking Cup Apparatus" and are related to a rather simple device — a sippy cup.

After close of expert discovery, the district court entered summary judgment that the '931 patent is not infringed, and that the claims of the '620 patent are invalid.

On February 23, 2007, the Federal Circuit affirmed and on May 2, 2007 the Federal Circuit denied Petitioner's combined petition for panel rehearing and rehearing en banc.

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[2] It should be noted that the Federal Circuit denied Petitioner's Petition for Panel Rehearing and Rehearing en banc. Fed. R. App. P. 40(a)(2) requires that a petition for panel rehearing state with particularity each point of law or fact that the petitioner believes the court has overlooked or misapprehended. A panel rehearing petition is not to be used merely to reiterate arguments previously rejected by the court. *See* 2A Fed. Proc., L. Ed. § 3:926 (2006); *see also United States v. Molina-Tarazon*, 285 F.3d 807, 808 (9th Cir. 2002). Rehearing en banc "is not favored and ordinarily will not be ordered unless" it is necessary to ensure uniformity of the court's precedent or the proceeding "involves a question of exceptional importance." Fed. R. App. P. 35(a).

In issuing and affirming judgment of non-infringement of the '931 patent, the courts below relied on the clear and unambiguous statements the patentee made to the PTO to obtain patent allowance. Specifically, after the PTO rejected all of the pending application claims as being "clearly anticipated" by the prior art (*see* A0218-A0220)[3], the patentee distinguished his claimed invention by repeatedly arguing that his invention required "two separate mechanisms" to block liquid flow out of the cup. *See* A0222-A0230. The patentee explained that one of those closure mechanisms is a flexible valve member having a slit that independently blocks fluid flow and that the other mechanism is a blocking element, which presses against the slit to *further* block fluid flow:

> When a person drinks from a cup constructed in accordance with the invention, suction (negative air pressure) is applied to the flexible valve material. This suction causes the flexible material to lift off of the blocking elements, moving the *slit* off of that blocking element. *In addition, since the valve material is flexible, the flexing of the material will also stretch the slit, facilitating the passage of liquid through the valve.*
>
> When a person finishes drinking or when the cup sits on a table, no suction is being applied to the valve. During this time, the flexible valve sits with the slit against the blocking element. In addition, *the slit is not being stretched and is in a closed position.*

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[3] Citations to Axxxx refer to the joint appendix provided to the Federal Circuit in the record below.

> *Thus, two separate mechanisms are both used to close off the passage of liquid through the valve when not in use.* The first mechanism involves an inverting, flexible valve material which has *a slit* therein and responds to suction. The second mechanism involves the use of a blocking element, which is impenetrable to the passage of liquid. The slit sits against the blocking element, sealing or blocking off the slit, *to yet further prevent the passage of liquid through the valve.*

See A0227-A0228 (emphasis added).

To further distinguish his claimed invention over the prior art, the patentee emphasized that the additional sealing provided by the blocking element reinforces the independent ability of the valve member's slit to block liquid flow:

> By providing both the elastomeric member with *a slit* and a blocking element, a sealing mechanism is provided which reduces spillage *beyond that of either mechanism alone.*

See A0228 (emphasis added).

While most of the rejected application claims recited an "opening" as opposed to a "slit," (*see* A0252-A0258 (original application claims 1-30)), the patentee indisputably relied on the special characteristics of a "slit" (*i.e.*, normally-closed when unstretched) to distinguish "*all* of the pending claims" from the prior art:

> None of the references cited in the Office Action teach or suggest such a no-spill mechanism having

> *a slit* sitting against a blocking element *such as is recited in all of the pending claims.*

See A0228 (emphasis added).

Based on these arguments, the PTO allowed all of the pending application claims—both those referring to an "opening" and those referring to a "slit."

Following such allowance, however, the patentee continued the prosecution of his patent application. *See* A0260-A0268. He amended two of the previously allowed claims that recited a "slit" by changing the word "slit" to "opening." *See* A0266-A0267. In doing so, however, the patentee presented *no* new patentability arguments. Instead, he expressly relied on his previous arguments concerning the importance of a slit-like "opening." *See* A0264. On that basis, the '931 patent was issued.

REASONS FOR DENYING THE PETITION

1. The Federal Circuit's Ruling Of Prosecution Disclaimer Follows The Well Established Precedent Of This Court

Contrary to Petitioner's assertions, the Federal Circuit did *not* proclaim a "new rule of prosecution history disclaimer" that is contrary to this Court's precedent. Moreover, the very premise for Petitioner's argument — that the Federal Circuit supposedly read back into the claims of the '931 patent a limitation that was removed during prosecution — is simply not true.

As the Federal Circuit correctly noted, to overcome a prior art rejection by the PTO, the patentee distinguished his invention from the cited prior art on the basis that his invention requires two separate closure mechanisms to block the flow of fluid. One mechanism consists of a *"flexible valve material which has a slit." See* Appendix A at 3a (emphasis in original). The other mechanism involves the use of a "blocking element, which is impenetrable to the passage of liquid." *See* Appendix A at 4a. The combination provides a mechanism "which reduces spillage *beyond that of either mechanism alone.*" *See* Appendix A at 4a (emphasis added).

The Federal Circuit quoted the patentee's argument as follows:

> Thus two separate mechanisms are both used to close off the passage of liquid through the valve when not in use. The first mechanism involves an inverting, *flexible valve material which has a slit* therein and responds to suction. The second mechanism involves the use of a blocking element, which is impenetrable to the passage of liquid. The slit sits against the blocking element, sealing or blocking off the slit, to yet further prevent the passage of liquid through the valve.
>
> . . . . By providing *both the elastomeric member with a slit and a blocking element,* a sealing mechanism is provided which reduces spillage beyond that of either mechanism alone. None of the references cited in the Office Action [Robbins III, Bachman, and Belcastro] teach or suggest such

> *a no-spill mechanism having a slit sitting against a blocking element such as is recited in all of the pending claims.*
>
> '931 Application Response, Oct. 2, 2000 (emphases added).
>
> Thus during prosecution the presence of the slit in the flexible valve material was emphasized as distinguishing *all* of the claims from the cited references.

See Appendix A at 4a (emphasis added).

The Petition implies that the claims that were the subject of the patentee's prosecution arguments were only claims that recited "slit" and that when those claims were later amended to "remove" the term "slit" in favor of "opening," the earlier prosecution arguments were rescinded. But, that is not what happened.

At the time of the patentee's arguments, thirteen of the nineteen claims pending in the '931 patent application recited "opening." Only six claims recited "slit." *See* A0222-A0226. And, as the Federal Circuit noted, the patentee expressly represented that his argument applied to "all" the claims pending at the time. *See* Appendix A at 4a. That included claims that recited "opening" rather than "slit." *See* A0222-A0230. The patentee's argument defined the scope of his invention as requiring an opening that operates as a "slit." The patentee thus disclaimed a construction in which "opening" means any type of hole or opening whatsoever, as Petitioner now argues.

Petitioner cites *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211 (1940) for the proposition that a limitation may not be read back into the claims after it was expressly removed during prosecution. *See* Petition at 15. But, that is not at all what happened here. Here, the patentee applied his arguments regarding the necessary characteristics of a "slit" to his invention's two separate sealing mechanisms to distinguish claims that recited "opening," as well as claims that recited "slit." The patentee's representation to the PTO that his arguments applied to "all" his claims, even those that recited "opening," characterized his invention as a whole. Indeed, without a slit-like opening, the required two separate sealing mechanisms — that the patentee argued distinguished over the prior art — would not exist.

Petitioner's argument now that by amending some allowed claims to recite an "opening" rather than a "slit" he effectively rescinded his prosecution disclaimer and broadened his claim scope such that the term "opening" means any type of hole or orifice does not comport with reality.

Petitioner stretches the facts when he suggests that he rescinded his previous arguments because he told the PTO he was broadening his claims. *See* Petition at 20. In fact, the Petitioner downplayed the significance of his amendments referring to them as "minor" and "slight"; and, he expressly reaffirmed his previous arguments for patentability. Specifically, the patentee stated:

> In the Notice of Allowance dated December 22, 2000, all of the claims in this application were found to present patentable subject matter. In the present CPA, Applicant is entering *minor* changes

> to Claims 1-2 to claim "an opening" as opposed to "a slit", and to recite "a slit" in dependent claims thereto. This change *slightly* broadens the scope of the first two claims. However, both claims still present patentable subject matter; *the other independent claims of the application previously recited an opening, and all of those claims were deemed to be patentable.*

See A0264 (emphasis added).

Seen in the full context of his prosecution remarks, the Petitioner's assertion that the later amendment of some claims to recite "opening" was a rescission of the patentee's earlier patentability argument is fiction. The patentee's representation to the PTO that the later amendment "slightly broadens" the claim scope clearly refers to the fact that the term "opening" encompasses other slit-like openings such as the "T-shaped" and "Xshaped" "openings" disclosed in the patent specification (*see* A0193, col. 8, lines 62-65), which operated in the same way as a slit but technically were not a single cut in the flexible material. The "minor changes" to "slightly broaden" some claims certainly did *not* signal a wholesale reversal of the narrowed meaning of "opening" that the patentee emphatically relied on to overcome the Examiner's prior art rejections.

Petitioner's suggestion that the doctrine of "claim differentiation" precludes the claim construction found by the Federal Circuit and district court is wrong. First, "claim differentiation" does *not* apply here at all. There are *no* different claims that are being interpreted such that they are identical in scope. As both the Federal Circuit and district court held, the independent claims that recite "opening" must

be construed to be slit-like so as to provide the necessary two sealing mechanisms that the patentee represented to the PTO was the basis for distinguishing his invention over the prior art. *See* Appendix A at 8a-9a. As such, "opening" can comprise a slit as well as the T-shaped and X-shaped "openings" that, like a slit, are normally closed to block fluid but which, upon the application of suction, stretch open to allow fluid to pass. The dependent claims that recite "slit" specify one particular "opening" among the various possibilities of "slit," "X shape" and "T shape" that are generally encompassed by the independent claim. There is no identity of scope between claims reciting "opening" and those specifying "slit."

In any event, it is well settled that the doctrine of claim differentiation is merely a guideline that is trumped by prosecution disclaimer. *Seachange Int'l., Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1369 (Fed. Cir. 2005) (holding that the doctrine of claim differentiation is not a hard and fast rule and will be overcome by a contrary construction dictated by the written description or prosecution history).

Petitioner's argument that the Federal Circuit's decision has created a new rule of law that threatens to evaporate untold patents directed to pioneering inventions is absurd, bears no relation to the facts of this case and is nothing more than a scare tactic to obtain a rehearing where there is no basis for one.

Notwithstanding Petitioner's hyperbole, the simple facts here are that to distinguish his invention over the prior art, the patentee repeatedly and unequivocally defined his invention and claim scope in the same way with respect to claims that recited "opening" as well as claims that recited

"slit." When the patentee later removed the term "slit" from some of the allowed claims, he represented to the Examiner that the amended claims were allowable for the same reasons he had earlier argued in connection with claims reciting "opening." He in no way broadened the limited meaning of "opening" that he had earlier urged to successfully obtain claim allowance.

In finding a prosecution disclaimer, the Federal Circuit relied on well-established precedent of this Court that expressly holds that a patentee cannot argue that his invention is one thing during prosecution and then some broader thing in litigation. *See* Appendix A at 8a (citing *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003) ("The doctrine of prosecution disclaimer is well-established in Supreme Court precedent, precluding patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution."); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-21 (1940); *Crawford v. Heysinger*, 123 U.S. 589, 602-04 (1887); *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880)).

The Federal Circuit did *not* proclaim a "new rule of prosecution disclaimer" but rather followed the over one hundred year old precedent of this Court in construing the relevant patent claims.

2. The Federal Circuit's Claim Construction Is Consistent With This Court's Precedent

While petitioner complains broadly about how the Federal Circuit supposedly mishandles the issue of claim construction on a regular basis, he totally fails to present any compelling reason why the Federal Circuit's handling of claim construction *in this case* was wrong.

As discussed above, the Federal Circuit did not adopt a new rule of prosecution disclaimer. Rather, the Federal Circuit followed the well established precedent of this Court. *See* Appendix A at 8a. And, contrary to Petitioner's assertions, the doctrine of prosecution disclaimer that the Federal Circuit follows is fair to both patentee and the public.

> The public notice function of a patent and its prosecution history requires that a patentee be held to what he declares during prosecution of his patent. A patentee may not state during prosecution that the claims do not cover a particular device and then change position and later sue a party who makes that same device for infringement.

Spring Window Fashions L.P. v. Novo Indus., L.P., 323 F.3d 989, 995 (Fed. Cir. 2003).

As for the '620 patent, Petitioner complains that Federal Circuit and district court failed to do the proper claim construction analysis. But in fact, the courts below *did* construe all of the claim terms in dispute — "closed position" and "begins to invert" — and provided eminently reasonable bases for the construction. *See* Appendix A at 8a at 12a-14a.

Petitioner's complaint that the district court refused to hold a Markman Hearing or to take any testimony (*see* Petition at 10) should be rejected out of hand. There is *no* requirement that a court conduct a separate "Markman Hearing." *See Ballard Med. Prods. v. Allegiance Healthcare Corp.*, 268 F.3d 1352, 1358 (Fed. Cir. 2001). Indeed, it is common for the courts to perform claim construction in the context of summary judgment motions just as the district court did below. *See id.*

There also is no requirement that a court take testimony in the process of claim construction. It is well settled that it is the intrinsic evidence—the patent claims, specification and prosecution history—is of paramount importance in a claim construction analysis. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1315-1317 (Fed. Cir. 2005). While, after the fact testimony and other like "extrinsic" evidence may be used, it is *not* a requirement and, if used, can only be used to understand the court's understanding of the technology. *See EMI Group N. Am., Inc. v. Intel Corp.*, 157 F.3d 887, 892 (Fed. Cir. 1998).

Moreover, the only "evidence" that Petitioner asserts the Federal Circuit improperly failed to consider in its claim construction analysis was Petitioner's own self-serving, conclusory "expert" declaration that he submitted late, after the close of expert discovery. The district court properly excluded that so-called "evidence" and the Federal Circuit properly affirmed the district court's discretionary ruling to exclude. The Federal Circuit noted that Petitioner:

> . . . failed to provide a timely expert report or to submit himself for deposition, that expert testimony is not needed by the Court in this case, and that Hakim's testimony is self-serving, biased and of no assistance to the Court in understanding the 'technology' involved regarding the simple device at issue in this case.

See Appendix A at 14a-15a. The Federal Circuit further properly held:

> This discretionary ruling is not grounds for reversal, for we have not been shown how the trier

> of fact was led into error, or could reasonably have reached a different decision had the inventor's declaration been admitted. This evidentiary ruling was in accordance with the Rules, and is affirmed.

See Appendix A at 15a. There is no compelling reason for this Court to revisit the issue.

CONCLUSION

In the final analysis, Petitioner's broad sweeping assertions of error below are meritless. Petitioner has totally failed to demonstrate any compelling reason to grant a Petition for a Writ of Certiorari in this case.

It is respectfully submitted that the petitioner should be denied.

Accordingly, there is no compelling reason to grant certiorari here.

Respectfully submitted,

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